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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,594	11/20/2001	Mark A. Torrance	01-654	1648

7590 09/08/2004

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EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,594	TORRANCE ET AL.	
	Examiner	Art Unit	
	Vinh T Luong	3682	<i>NW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10, 11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 6, 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u> |

1. The Amendment filed on June 11, 2004 has been entered. Note that the Application Number of this application on pages 2-12 of the Amendment is incorrect. The Application Number of this application is 10/002,594 instead of 10/022,594. Applicant is respectfully urged to correctly identify the Application Number in order to avoid delay in matching of the paper with the file.

2. The drawings were received on June 11, 2004. The Examiner does not accept these drawings because Applicant does not identify in the top margin as "Replacement Sheet" or "Annotated Sheet." See INFORMATION ON HOW TO EFFECT DRAWING CHANGES below.

3. The original drawings are objected to because:

(A) Each part of the invention, such as, the brazing material in claim 12 should be designated by a referential numeral or character; and

(B) The drawings should show the plane 3-3 upon which the sectional view in Fig. 3 is taken.

See INFORMATION ON HOW TO EFFECT DRAWING CHANGES below.

4. The original drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature(s), such as, the brazing material in claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

5. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be

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presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lewis (US Patent No. 5,681,142).

Lewis teaches an assembly for preventing rotation of a damper 32 in a stator system 10 comprising a slot (an aperture. See column 3, lines 1-4) in said damper 32 in said stator system 10; and a block 30 for engaging said slot and thereby preventing said rotation of said damper 32.

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8. Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall et al. (US Patent No. 4,721,434).

Regarding claim 1, Marshall teaches an assembly for preventing rotation of a damper 34, 54, 56 in a stator system 10 comprising a slot 32" in said damper 34, 54, 56 in said stator system 10; and a block 30, 60 for engaging said slot 32" and thereby preventing said rotation of said damper 34, 54, 56.

Regarding claim 2, said stator system 10 includes an inner air seal 26, 58, and said block 30 is located in a groove 32' in said inner air seal 26. The process limitation, such as, "*machined*" is not accorded patentable weight in product-by-process claim. It is well settled that the patentability of a product does not depend on its method of production. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985); *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); *Ex parte Edwards*, 231 USPQ 981 (BPAI 1986); and MPEP 2113.

Regarding claim 3, said block 60 is located substantially at a mid span of the inner air seal 58 (Fig. 3).

Regarding claim 5, said block 30 has (rounded) side portions and said groove 32' has (rounded) side edges. The process limitation, such as, "said side portions of said block are *brazed* to said side edges of said groove" is not accorded patentable weight in product-by-process claim. *In re Thorpe*; *In re Brown*; *In re Fessmann*; *Ex parte Edwards*; and MPEP 2113 *supra*.

Regarding claim 7, Marshall's block or rivet 30 is inherently formed from a metallic material. The metallic rivet is notoriously well known in the art.

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9. Claims 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al.

Regarding claim 4, Marshall teaches the invention substantially as claimed. However, Marshall does not teach the dimension, such as, "said block has a height and said groove has a depth which is from about 50 to 65% of said block height."

It is common knowledge in the art to make Marshall's block having the dimensions as claimed in order to improve the damping of Marshall's stator system. See Marshall's Disclosure of Invention and legal precedents regarding changes in size/proportion in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Marshall's block having the dimensions as claimed in order to improve the damping of Marshall's stator system as taught or suggested by common knowledge in the art.

Regarding claims 7 and 8, Marshall teaches the invention substantially as claimed. However, Marshall does not teach the material such as metallic or non-metallic material for the block.

It is common knowledge in the art to make Marshall's block or rivet of metallic or non-metallic material in order to improve the damping of Marshall's stator system. The metallic or non-metallic rivet is notoriously well known in fastener art. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Marshall's block of metallic or non-metallic material in order to

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improve the damping of Marshall's stator system as taught or suggested by common knowledge in the art.

10. Claims 10, 11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Beckershoff (US Patent No. 3,986,779).

Regarding claim 10, Beckershoff teaches a stator system for use in an engine comprising:

a stator or the like 1 (see column 1, lines 22-34);

an inner air seal (see Attachment);

a damper 7' positioned between said inner air seal (Att.) and said stator 1;

said damper 7' having a slot 7'; and

a block 7'' for engaging said slot 7' in said damper 7' so as to prevent rotation of said damper 7' during engine operation. *Ibid.*, line 64 *et seq.*, column 4.

Regarding claim 11, Beckershoff's stator system further comprises a groove 2 machined in said inner air seal (Att.), and said block 7'' is positioned within said groove 2.

Regarding claim 13, said block 7'' has two chamfered edges 8 to allow said block 7'' to be positioned within said groove 2.

Regarding claim 14, said damper comprises a spring damper. *Ibid.*, line 32 *et seq.*, column 4.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckershoff.

Beckershoff teaches the invention substantially as claimed. However, Beckershoff does not explicitly teach to locate said block at a midspan of the inner air seal.

It is common knowledge in the art to rearrange Beckershoff's block at the midspan of the inner air seal in order to yield a good locking action performance of Beckershoff's stator system.

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See Beckershoff's Summary of the Invention and legal precedents regarding rearrangement of parts in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange Beckershoff's block at the midspan of the inner air seal in order to yield a good locking action performance of Beckershoff's stator system as taught or suggested by common knowledge in the art.

12. Claims 6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 12 is allowed.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hennessey et al. (stator blades 36), Ernest (damper 15), Pickering et al. (damper 24), and Mannava et al. (damper 50), and Bonner et al. (damper 70, 74).

16. Applicant's arguments filed June 11, 2004 have been fully considered but they are not persuasive.

Applicant states:

With regard to the rejection of claims 1, 2, 5, 6, 10, 11, 13, and 14 over Beckershoff, a review of this patent shows that it has nothing to do with the claimed invention. The Beckershoff patent is directed to a locking device for releasable fastening parts to rotors of fluid flow machines (see the Abstract; also see Brief Description of FIG. 1 which clearly says that FIG. 1 is a perspective view of a

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rotor disk). Referring now to FIGS. 1 - 3 of Beckershoff, there is illustrated a rotor (3) having a plurality of fixing slots (2) into which an interconnect piece (1) is to be placed. The interconnect piece (1) has a foot (5) with a groove (10) and a fastening element (7) for securing an interconnect piece in a slot (2). The fastening element (7) includes a key (7") which fits into the groove (10) which forms a keyway and a spring (7') for holding the key (7") in place. There is absolutely nothing in the Beckershoff patent which relates to an assembly for preventing rotation of a damper in a stator system.

The Examiner respectfully submits that Applicant apparently uses an "*ipsissimis verbis*" test that requires the same terminology in the prior art in order to find anticipation. See footnote 11 in *AKZO N.V. v. International Trade Commission*, 1 USPQ2d 1241, 1245 (CAFC 1986). In the instant case, Beckershoff does not need to use Applicant's lexicography such as "a stator" to anticipate Applicant's claims. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

In addition, as noted in MPEP 2111, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *IntervetAmerica Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12

USPQ2d 1474, 1476 (Fed. Cir. 1989). Further, words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. Where an applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01.

In the instant case, Applicant does not provide any special meaning for the term "a stator system." Therefore, the Examiner relies on the definition of the term "stator" as being "a stationary machine part in or about *a rotor* turns" in *McGraw-Hill Dictionary of Scientific and Technical Terms* 1976, page 1416, attached.

On the other hand, Applicant admitted that "[t]he Beckershoff patent is directed to a locking device for releasable fastening parts to *rotors* of fluid flow machines." Since Beckershoff teaches the rotor system, therefore, Beckershoff's rotor system inherently has or must have the stator about which Beckershoff's rotor turns as defined by *McGraw-Hill Dictionary*. Otherwise, Beckershoff's rotor would be inoperative. Therefore, Beckershoff patent which relates to an assembly for preventing rotation of a damper in a rotor system inherently relates to a stator system. On the other hand, Beckershoff defines in column 1, lines 22-34:

In the context of this disclosure the term "part or component", which is intended to be fixed to a rotor or the like, is employed in its broadest sense as embracing one or more parts which are intended to be secured to a rotor of a machine, typically a fluid flow machine. Equally, the term "rotor" as used in the context of this disclosure is employed in its broader sense to encompass

generally an annular element, such as a rotor or rotatable wheel of such machine. Purely by way of example, and not limitation, the parts to be fastened to the rotor may be constituted by buckets or intermediate elements, wherein the rotor by way of example may be the wheel of a turbine. (Emphasis added).

In other words, Beckershoff's part or component 1 in its broadest sense embraces the stator which is intended to be secured to Beckershoff's rotor 3 so that the rotor 3 is turned in or about. Consequently, there are numerous things in the Beckershoff patent which relate to an assembly for preventing rotation of a damper in a stator system.

Second, Applicant's contention about the intended use such as "for prevention rotation of a damper in a stator system" is not accorded patentable weight. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the case at hand, contrary to Applicant's remarks by using the "*ipsissimis verbis* test," Applicant's each and every limitation of claims 10, 11, 13, and 14 is "fully met" as set forth in the above rejection. See *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Therefore, the rejection of claims 10, 11, 13, and 14 under 35 USC 102(b) based on Beckershoff is respectfully maintained.

With respect to claims 1, 2, 5, and 6, Applicant amended claim 1 to recite "a slot in said damper *in said stator system*." In other words, the preamble of claim 1 now is accorded

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patentable weight because the body of claim 1 refers back to the preamble. See *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 62 USPQ2d 1781 (CAFC 2002). Since Beckershoff does not teach the slot in the damper in the stator system, hence, the previous rejection of claims 1, 2, 5, and 6 under 35 USC 102(b) based on Beckershoff is withdrawn. However, the amendment in claim 1 necessitated new ground of rejection and the dependent amended claims 3, 4, and 7 are rejected therewith as seen in this Office action.

With respect to claim 9, the Examiner agrees that amended claim 9 is allowable.

Applicant further contends that claim 15 is allowable for the same reason that claim 3 is allowable. Nevertheless, claim 15 has different scope than the one of claim 3. In fact, claim 15 does not include the limitation "a slot in said damper *in said stator system*" as evidenced by its independent claim 10. Therefore, the rejection of claim 15 under 35 USC 103 based on Beckershoff is maintained.

For the foregoing, the case is not in the condition for allowance.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

September 7, 2004


Vinh T. Luong
Primary Examiner

ATTACHMENT

